

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** PHILIP CRISTAL

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Appeal No. 1999-1618  
Application No. 08/358,354

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ON BRIEF

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Before KRASS, JERRY SMITH, and DIXON, **Administrative Patent Judges**.  
DIXON, **Administrative Patent Judge**.

**DECISION ON APPEAL**

This is a decision on appeal from the examiner's final rejection of claims 14, 15, and 17, which are all of the claims pending in this application.

We REVERSE.

## **BACKGROUND**

The appellant's invention relates to a mobile telephone having a touch sensitive display and input device. The touch sensitive device allows the display of a message menu containing voice and text messages and a plurality of known and unknown callers. The display further contains a scrolling function which allows selection of a "listen" function which initiates a call to a voice message service to retrieve/ listen to voice mail messages. An understanding of the invention can be derived from a reading of exemplary claim 14, which is reproduced below.

14. A mobile telephone, comprising:

a display and associated soft keys;

a soft key referenced with a designation "message" in a stand by mode of the mobile telephone, the designation "message" flashing upon reception of a message via short message service or caller line identification;

a message menu that is displayed when said soft key is pressed, said message menu containing messages in regards to a voice message, a text message including a plurality of new or old messages and a plurality of at least one of known callers and unknown callers;

a scroll system such that a user scrolls to a desired message and presses either a soft key "listen" or a soft key "view";

a call to a voice message service being initiated by pressing the soft key "listen", remaining access control being in agreement with a voice message service center by using voice or coded cryptocommands, upon initial access to the voice message center, the user activating a predetermined key and inputting a required telephone number, soft key

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legends being used for marking an end of a message and for offering existing possibilities of modifying and erasing messages.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Kasper et al. (Kasper)	5,177,780	Jan. 5, 1993
Thompson	5,465,401	Nov. 7, 1995

Fennell, J. Kim, "Voice Processing on the mobile Network," **Telecommunications** (International Edition), Vol. 27, No. 2, pp 82-86 (Feb. 1993)

Claims 14, 15, and 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Thompson and Kasper in view of Fennell.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 13, mailed Nov. 9, 1998) for the examiner's reasoning in support of the rejections, and to the appellant's brief (Paper No. 12, filed Sep. 10, 1998) for the appellant's arguments thereagainst.

### **OPINION**

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the

respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Appellant argues that the combination of Thompson, Fennell and Kasper does not teach or suggest the claimed structure as set forth in claim 14 wherein soft keys are used with a scroll system for utilizing various services with a mobile telephone. (See brief at page 5.) We agree with appellant.

Beyond the above argument, appellant does not argue the specific limitations with respect to the combination of references. Appellant paraphrases the examiner position and paraphrases the language of claim 14 (brief at pages 6 and 7), but does not argue the limitations of the claims. Appellant maintains that the Fennell reference is more in the realm of a wish list than an actual teaching. (See brief at page 7.) It is unclear to us whether appellant intends this to be an argument directed to a non-enabling reference. Therefore, this argument is not persuasive. Appellant generally argues that the combination of Thompson and Fennell would not result in the invention as recited in claim 14. Appellant argues that independent claim 14 recites a soft key which is in a standby mode, a message menu which contains references to voice messages, text messages and known and unknown callers which we assume to be an argument that the combination of Thompson and Fennell does not teach or suggest. We agree with appellant. Appellant argues that the further combination of Kasper with respect to audible notification of voice

mail rather than a visual notification does not result in the invention as recited in independent 14. We agree with appellant that the combination would not teach or suggest the claimed invention as maintained by the examiner.

The examiner admits at page 5 of the answer that the combination of Thompson and Fennell “fail[s] to disclose a call to a voice message service being initiated by pressing the soft key. Nevertheless, Kasper discloses having a voice mail notification arrangement provides an audible notification, instead of a visual notification, to a mobile radiotelephone that one or more incoming calls have been directed to a subscriber’s mailbox . . . the use can activate a key and input the required telephone number.” (See answer at page 5.) Here, the examiner cites to Kasper for support, yet we find no support for the examiner reliance on Kasper to teach or suggest the limitation admitted as lacking in the base combination. The examiner then merely concludes that it would have been obvious to one of ordinary skill in the art at the time of the invention to place a call to a voice message service to be initiated by pressing a soft key, in order to allow subscribers to access their voice mail in efficient and reliable manner. (See answer at page 5.) We disagree with the examiner. From our review of Kasper, we find no teaching or suggestion to place a “call to a voice message service being initiated by pressing the soft key ‘listen’” as recited in claim 14. Kasper does not disclose or suggest the use of an soft key type functions or a standard speed dial function from which to teach or suggest a shortcut to access voice

mail. Nor is this taught or suggested by either Thompson or Fennell. Thompson teaches a basic telephone configuration in Fig. 7 elements 60 and 60a. In Fig. 8, Thompson further discloses a menu to select various applications for the display on elements 60 and 60f. Again, Thompson discloses an enhanced phone application in Fig. 9a with additional functions 154, but does not disclose detail thereto. While Fennell does discuss the motivation to notify the user of messages to encourage further phone usage in the section labeled "The Key to Success" (at page 4 of the DIALOG™ service printout), Fennell merely states that the customer is encouraged to "call in and check messages." In our view this is not a sufficient motivation or suggestion to initiate a call using a soft key. Nor has the examiner provided a convincing line of reasoning as a motivation for a modification of the prior art combination to meet this claimed feature. The examiner's response to appellant's general arguments is that appellant is arguing the references individually. We disagree, while appellant's arguments are not clearly set forth, appellant does address the claim limitations and the combined teachings of the references.

On page 7 of the answer, the examiner maintains that Thompson teaches various aspects of the claimed invention including a "soft key 'listen'; a soft key 'view', a message menu which contains references to voice messages, text messages and known and unknown callers." The examiner cites generally, Figures 7-9(a)-(d) for support of these teachings. We disagree with the examiner, and do not find the "listen" and "view" soft keys,

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nor the message menu as claimed. Since the examiner bears the initial burden of establishing a ***prima facie*** case of obviousness, and since we find that the examiner has not established a ***prima facie*** case of obviousness, we cannot sustain the rejection of the sole independent claim 14 and dependent claims 15 and 17.

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### **CONCLUSION**

To summarize, the decision of the examiner to reject claims 14, 15, and 17 under 35 U.S.C. § 103 is reversed.

### **REVERSED**

ERROL A. KRASS  
Administrative Patent Judge

JERRY SMITH  
Administrative Patent Judge

JOSEPH L. DIXON  
Administrative Patent Judge

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